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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|-------------------------------|------------------------|
| 09/677,502 | 10/02/2000 | Yoshio Hashibe | 0694-134 | 4484 |
| 7590 Bradley N. Ruben PC 463 First St. Suite 5A Hoboken, NJ 07030 | | 03/27/2007 | EXAMINER SERGEANT, RABON A | |
| | | | ART UNIT 1711 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/677,502

Applicant(s)

HASHIBE ET AL.

Examiner

Rabon Sergeant

Art Unit

1711

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 February 2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,2,4,6 and 8-12.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).


10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.


Rabon Sergeant
Primary Examiner
Art Unit: 1711

Continuation of 3.: The proposed amendment sets forth claim limitations that have not been set forth previously that would require further consideration and search. Furthermore, the proposed transitional language has not been previously claimed; therefore, it has not been previously established what would have a material effect and consequently it has not been established what is excluded by the language.

Continuation of 11.: Applicants' response is largely based upon amendments that will not be entered. Accordingly, the rejections set forth within the final Office action have been maintained for the reasons previously set forth. Applicants have argued that Terneu et al., Arfsten et al. Benson et al., and Stephens are non-analogous art, with respect to the invention. In response, given that the instant invention is concerned with preventing the transmission of infrared rays or heat rays, and the teachings of the primary reference that heat reflectance treatments may be used within firescreening applications, the position is taken that the secondary references, disclosing the use of heat reflectance glazing materials, are analogous art, because it can be reasonably argued that they are within the field of applicants' endeavor, and it can be further argued that the secondary references are reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171,174. In re Clay, 23 USPQ2d 1058. It is noted that applicants' arguments are silent with respect to Plumat et al. Applicants have argued that Friedman et al. teach away from the use of Hentzelt et al.'s intumescent material. In response, applicants' claims are not commensurate in scope with the presented arguments, because the claims do not exclude such materials. Furthermore, while Friedman et al. disclose that the use of intumescent materials may be disadvantageous, contrary to applicants' assertions, there is no concrete or definitive teaching away from the use of such materials, in that applicants' provide no disclosure that such materials could not be used in their invention. One willing to accept the disadvantages, would have found it obvious to utilize such materials as a means of preventing the transmission of heat rays. With respect to arguments concerning Hentzelt et al.'s use of PVB material, it noted that the use of this material is optional within Hentzelt et al. and that Friedman et al. disclose how their fluoropolymer may be used in place of PVB. Therefore, the cumulative teachings of these two references establish how intumescent materials could be used or not used, as desired, and how fluoropolymers may be used in place of PVB. Lastly, despite applicants' arguments, the position is maintained that Friedman et al. clearly suggest to one of ordinary skill that heat reflectance treatments can be used. Applicants' argument that Friedman et al. teach away from a physical coating, because surface corona treatment is a surface treatment, rather than a coating is without merit. The argued surface corona treatment applies to the film and is not seen to exclude any other treatment or coating of the disclosed layers of the laminate or structure, especially in view of the argued teachings within column 6. Furthermore, applicants have not distinguished surface treatments from coatings; therefore, the significance of arguments pertaining to this issue is unclear.


RABON SERGENT
PRIMARY EXAMINER